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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,422	03/26/2001	JUTTA KLOWER	29462-025	6387

7590

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EXAMINER

OLTMANS, ANDREW L

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 06/09/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/355,422

Applicant(s)

KLOWER ET AL.

Examiner

Andrew L Oltmans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 8-14 remain pending in this application. The amendment filed October 23, 2000 has been entered. The substitute specification filed October 23, 2000 has been entered. It is noted that the Notification of Acceptance of Application (Form PCT/DO/EO/903) has a 35 U.S.C. 371(c) date of March 26, 2001. This Office Action is NON-FINAL.

### ***Specification***

2. The substitute specification filed October 23, 2000 has been entered because it conforms to 37 CFR 1.125(b) and (c). The examiner notes that the requirements were fully met upon the correspondence of December 17, 2001, wherein the applicant stated that no new matter had been added to the Substitute Specification.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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***German Patent 1,233,609***

4. Claims 8-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent 1,233,609 cited in IDS filed September 13, 1999 ('609).

'609 teaches 5-30% Cr, 0-15% Mo, 0-1.5% Si, 0.01-0.3% C, 0-5% Fe, 0-1% Mn, 0.1-9% Al, 0.1-6.5% Ti, less than 0.15% Mg, 0-6% V, less than 0.02% P, less than 0.01% S, 0-0.3% B, 0-0.9% Cu, 0-30% Co, 0-7% Nb, 0-8% Hf, 0-1.2 Zr, balance Ni and impurities, which overlaps that recited in the instant claims (claims 8-11). The product recited in claim 14 does not distinguish over the material taught in '609.

'609 fails to meet all the limitations of the instant claims in that '609 does not explicitly teach the exact compositional ranges recited in the claims, the austenitic structure, or the Ca.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by the reference has a composition which overlaps that of the instant claims. It would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in '609 because '609 finds that the prior art composition in the entire disclosed range has a suitable utility. See In re Peterson, 65 USPQ2d 1379, In re Malagari, 182 USPQ 549, and MPEP 2144.05.

With respect to the austenitic structure, although the reference remains silent to the structure of the alloy, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy composition taught by the references overlap the alloy composition recited in the claims and therefore one of ordinary skill

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in the art would expect that the products taught by the references would be the same as applicant's claimed product, including the properties of structure, MPEP 2112.01.

With respect to the Ca, although the reference is silent to Ca, one of ordinary skill in the art would recognize that Ca is a known impurity for nickel-chromium alloys. In view of the fact that Ca is a known impurity, one of ordinary skill in the art would recognize that the impurities in the alloy taught by the reference would include Ca.

***German Patent 1,233,609 in view of Kitashima et al. 4,325,994***

5. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent 1,233,609 cited in IDS filed September 13, 1999 ('609) in view of Kitashima et al. 4,325,994 (Kitashima).

'609 teaches and is applied as set forth above in paragraph 4.

'609 fails to meet all the limitations of the instant claims in that '609 does not explicitly teach the various products claims in claims 12-13.

Kitashima teaches that Ni-Cr-Mo alloys are known as being suitable for the claimed products recited in claims 12 and 13 because the material is resistant to corrosion, particularly in seawater and corrosive liquid environments (col 1, lines 20-64).

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the products claimed in claims 12-13 are well-known applications of Ni-Cr-Mo alloys, as taught in Kitashima, and one of ordinary skill in the art would have been motivated to use the alloy taught in '609 in one of the applications

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recited in Kitashima in order to provide products that is resistant to corrosion, particularly in seawater and corrosive liquid environments.

***Response to Arguments***

6. Applicant's arguments filed October 23, 2000 have been fully considered but they are not persuasive. In view of applicant's amendments the reliance on Kondo et al. 4,110,110 has been withdrawn. Likewise, in view of applicant's amendments the rejections under (35 USC) 101 and 112 and the objections have been withdrawn. However, the 103 rejection based upon German Patent 1,233,609 has been maintained and applied against newly presented claims 8-11 and 14 (claims 12-13 in view of Kitashima).

7. The examiner maintains that the compositions taught in '609 overlap the compositions instantly claimed. Therefore, the claimed compositions are obvious, see MPEP 2144.05.

8. Applicant's arguments on pages 11-14 of applicant's amendment filed October 23, 2000 attempt to show that a portion of the range of the '609 reference is either undesirable or is not required. The arguments fail to establish new and unexpected results for the claimed range. The overlap of the compositional ranges is sufficient to render the claims obvious. MPEP 2144.05:

*Applicants can rebut a prima facie case of obviousness based on overlapping ranges by showing the criticality of the claimed range. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results. [emphasis added]*

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In this case, the criticality of the claimed range has not been established. The applicant has failed to provide sufficient evidence to show that the range claimed is critical to achieving unexpected results over the prior art, MPEP 716.02(d):

*To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. In re Hill, 284 F.2d 955, 128 USPQ 197 (CCPA 1960).*

The conclusory statements in the specification do not establish that the claimed range achieves unexpected results relative to the prior art range. Further the arguments do not establish that the prior art teaches away from the claimed invention. In view of the fact that the range taught in '609 overlaps the range claimed in claims 8-11, the claims are obvious, see MPEP 2144.05.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Oltmans whose telephone number is 571-272-1248. The examiner can normally be reached from 7:00 to 3:30, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrew L. Oltmans  
Patent Examiner  
Art Unit 1742

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